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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,941	07/25/2003	Michael Hendricksen	017534-005301US	3677
20350 7590 02/03/2010 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
PATEL, NIHIR B				
ART UNIT		PAPER NUMBER		
3772				
MAIL DATE		DELIVERY MODE		
02/03/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/627,941

Applicant(s)

HENDRICKSEN ET AL.

Examiner

NIHIR PATEL

Art Unit

3772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Response to Argument filed on 07/09/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19-44, 46, 47, 49, 53-57, 59 and 70-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-17, 19-44, 46, 47, 49, 53 and 70-77 is/are allowed.
- 6) ☒ Claim(s) 54-57 and 59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-646)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claims 54-57 and 59 if re-written in independent form is withdrawn in view of the newly discovered reference(s) to Lambrecht et al. (US 6,896,690). Rejections based on the newly cited reference(s) follow.
2. Claims **1-17, 19-44, 46, 47, 49, 53 and 70-77** are allowed. The prior art does not disclose a valve protector region that at least partially surrounds the valve member to maintain the default shape, wherein the valve protector region comprises a plurality of struts; and a retainer region connected to the valve protector region, the retainer region being formed of a plurality of interconnected struts configured to engage an interior wall of the bronchial passageway to retain the flow control device in a fixed location therein, the retainer region being movable from a contracted state suitable for introduction into the bronchial passageway to an expanded state suitable for engaging the interior wall of the bronchial passageway.

Terminal Disclaimer

3. The terminal disclaimer filed on July 9th, 2009 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 6,941,950 issued on September 13th, 2005 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims **54-57 & 59** are rejected under 35 U.S.C. 102(e) as being anticipated by Lambrecht et al. (US 6,896,690).
6. **As to claim 54**, Lambrecht teaches an apparatus that comprises a valve member **90** (see **fig. 17E; col. 15 lines 63-67**) that regulates fluid flow through the flow control device; a frame formed of a plurality of interconnected struts configured to engage an interior wall of the bronchial passageway to retain the flow control device in a fixed location therein (see **col. 15 lines 63-67 and col. 16 lines 1 and 2; the struts 92 and rings 91 define the frame with plurality of interconnected struts that secure the device to a vessel wall**), the frame being movable from a contracted state suitable for introduction into the bronchial passageway to an expanded state suitable for engaging the interior wall of the bronchial passageway (**the fact that the rings 91 are expandable implies that the frame are movable from a contracted state to an expanded state**); at least one retention prong **83** extending from the frame and configured to engage the interior wall of the bronchial passageway to resist migration therein (see **col. 15 lines 63-65**), wherein the retention prong comprises an axial post having a first end connected to the

frame and a free end opposite the first end (see **fig. 17E**; **col. 15 lines 63-67 and col. 16 lines 1 and 2**).

7. **As to claim 55**, Lambrecht teaches an apparatus wherein the retention prong **83** is fixed to the struts **92** of the frame (see **fig. 17E shows the prong 83 attached to strut 92**).

8. **As to claim 56**, Lambrecht teaches an apparatus wherein the struts **92** form a series of undulating loops in the contracted state, the retention prong being disposed between at least a portion of the loops (see **fig. 17E**).

9. **As to claim 57**, Lambrecht teaches an apparatus wherein the retention prong is loop shaped in the contracted state, and is expandable to have a V-shape in the expanded state (see **fig. 17C**).

10. **As to claim 59**, Lambrecht teaches an apparatus wherein the retention prong **83** is configured to project radially outwardly in the expanded state (see **fig. 17E**).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIHIR PATEL whose telephone number is (571)272-4803. The examiner can normally be reached on 7:30 to 4:30 every other Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nihir Patel/
Examiner, Art Unit 3772

/Patricia Bianco/

Supervisory Patent Examiner, Art Unit 3772